

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: Toni KOPRA	Confirmation No.: 8331
Application No.: 09/580,583	Group Art Unit: 3622
Filed: May 30, 2000	Examiner: Yehdega Retta

For: LOCATION AWARE PRODUCT PLACEMENT AND ADVERTISING

Commissioner for Patents
Alexandria, VA 22313-1450

REPLY BRIEF

Dear Sir:

This Reply Brief is submitted in response to the Examiner's Answer mailed October 27, 2009.

I. STATUS OF THE CLAIMS

Claims 19, 22-34, 41, 45-47, and 49-53 remain rejected under 35 U.S.C. §103.

Specifically, claims 19, 22-24, 28, 29, 34, 41, 45-47, 49, and 50-53 remain rejected as obvious under 35 U.S.C. § 103 based on *Rangan et al.* (6,006,265) in view of *Applicant's Background* and further in view of *Bandera et al.* (US 6,332,127) and *Owa et al.* (US 6,711,379), and claims 25-27 and 30-33 remain rejected as obvious under 35 U.S.C. § 103 based on *Rangan et al.* (6,006,265) in view of *Applicant's Background*, *Bandera et al.* (US 6,332,127) and *Owa et al.* (US 6,711,379) and further in view of *Saha et al.* (US 6,198,935).

II. GROUND OF REJECTION TO BE REVIEWED

Whether claims 19, 22-24, 28, 29, 34, 41, 45-47, 49, and 50-53 are obvious under 35 U.S.C. § 103 based on *Rangan et al.* (6,006,265) in view of *Applicant's Background* and further in view of *Bandera et al.* (US 6,332,127) and *Owa et al.* (US 6,711,379)?

Whether claims 25-27 and 30-33 are obvious under 35 U.S.C. § 103 based on *Rangan et al.* (6,006,265) in view of *Applicant's Background*, *Bandera et al.* (US 6,332,127) and *Owa et al.* (US 6,711,379) and further in view of *Saha et al.* (US 6,198,935)?

III. ARGUMENT

Appellant maintains and incorporates the positions presented in the Appeal Brief filed July 30, 2009, but presents further refutation of certain assertions presented in the Examiner's Answer.

At page 11 of the Answer, the Examiner asserted "the only difference between Rangan's invention and Appellant's claimed invention is the steps that are performed in Rangan are performed on a wireless device with mobile communication network." Respectfully, the Examiner's assertion is overly simplistic, as well as erroneous. The Examiner fails to appreciate the technical challenges involved. Clearly, *Rangan et al.* differs from the subject matter of the claims on appeal in more ways than merely lacking a mobile communications network, which it certainly does lack.

Rangan et al. discloses streaming digital hypervideo including embedded hyperlinks, the hypervideo being distributed on a digital communications network. However, in addition to lacking any teaching of a mobile communication network, *Rangan et al.* also lacks any teaching or suggestion of "the mobile communication network is a different network than the digital

broadcasting network,” as claimed. Of course, *Rangan et al.* cannot teach this claim feature because *Rangan et al.* lacks any teaching of a mobile communication network. However, there is no teaching or suggestion in *Rangan et al.* of any network being a different network than the digital broadcasting network because there is no teaching of **different** networks, in any form.

The Examiner asserted, at page 11 of the Answer, that at the time of the claimed invention, “wireless devices not only included a mobile communication network but were also capable of receiving broadcast signals,” citing, in part, “Appellant’s admitted art” as evidence of this allegation. However, what the Examiner alleges to be admitted prior art is not. All of the technology cited by the Examiner, at page 11 of the Answer, e.g., 3G, GSM/GPRS, etc, is cited in the instant specification but it is not in the “Background of the Invention” section of the specification. Rather, it is within the “Summary of the Invention” portion of the specification at page 4, and does not constitute admitted prior art. Thus, the Examiner’s reliance on “Admitted prior art” in the rejections of the claims on appeal is unfounded.

At page 11 of the Answer, the Examiner also cites the *Bandera et al.* and *Owa et al.* references for a disclosure of wireless devices receiving digital broadcasting, including multimedia data containing pictures, sound, text, and the like. While *Owa et al.* discloses digital broadcasting to mobile terminals, *Bandera et al.* is merely concerned with displaying advertising objects on a Webpage to Internet users.

At page 12 of the Answer, the Examiner cites various portions of *Bandera et al.*, concluding that this reference “teaches two communication systems, i.e., the Global Positioning system to obtain location information and the Internet for providing the Web pages and the advertisements. Bandera failed to teach that the second communication system is a digital

broadcasting system.” At pages 12-13, the Examiner quotes a large portion of col. 1 of *Owa et al.* relative to broadcasting multimedia data to mobile terminal devices.

Thus, the Examiner’s position appears to be that *Rangan et al.* discloses the receipt and display of a product image link, *Bandera et al.* discloses displaying a link to a resource with a mobile terminal and determining the location of the mobile terminal, and *Owa et al.* teaches a mobile communication network in combination with a “different” network in a digital broadcasting network since *Owa et al.* teaches a transmission from GPS satellites, as well as a broadcast signal from a digital broadcast system. Therefore, concludes the Examiner, it would have been obvious to combine these references in order to arrive at the instant claimed subject matter. This rationale, respectfully, is factually and legally flawed.

Even assuming that all of the elements of the claimed subject matter were present in the totality of the references, which they are not, the Examiner has offered no cogent rationale for combining these disparate elements in the manner claimed, as, for example, the video, including a product image link, is received from a digital broadcasting network and displayed on a mobile terminal, while a link is selected and, responsive to that selection, a location of the mobile terminal, determined by using a mobile communication network, wherein the mobile communication network is a different network than the digital broadcasting network. Additionally, content is received via the mobile communication network, with the content related to the link and to the location of the mobile terminal. Thus, the claimed elements have a very specific relationship with each other, relating to which network performs which functions and how the receipt of content and mobile terminal location are related. Without specific teachings in the applied references, it clearly would not have been obvious to take general teachings of networks, of mobile terminals, of displayed content, etc. and combine them in the specific

manner claimed. Yet, without a cogent rationale for doing so, the Examiner has combined the references through hindsight to arrive at the claimed subject matter.

Not one of the applied references discloses “the mobile communication network is a different network than the digital broadcasting network,” as claimed. Although the Examiner relies on *Owa et al.* for this feature, *Owa et al.* clearly does not teach this feature. That is, no reference or combination of references discloses or suggests the use of two **different** networks, *viz.*, **a digital broadcasting network** for receiving a video **and a mobile communications network** for determining a location of the mobile terminal in response to a receiving input selecting a link.

Col. 7, lines 40-52 and col. 9, lines 14-22 of *Owa et al.* discloses determining the location of a terminal and a relationship between the location and an object to be presented to a user. The location of the terminal is detected via a plurality of GPS satellites. Figs. 23 and 24, col. 20, lines 20-67, col. 21, line 56-col. 22, line 67, and col. 25, lines 3-33 disclose broadcast services, as where an automobile equipped with a terminal device comprises a GSP signal receiver for receiving GPS signals from satellites. *Owa et al.* provides a digital broadcasting network wherein broadcast multimedia data containing pictures, sounds, and texts are broadcast to the terminal of a mobile station (e.g., see col. 1, lines 35-64). However, there is no teaching in *Owa et al.* of employing **a mobile communications network** for determining a location of the mobile terminal **in response to a receiving input selecting a link**, as claimed. The terminal device in *Owa et al.* “includes a location judgment database which stores setting data indicating the relationship between the location of the self device and an object to be presented to the user,” with the location of the self device detected by receiving range signals transmitted from a plurality of GPS satellites (col. 7, lines 40-52) but nothing therein suggests employing **a mobile communications**

network for determining a location of the mobile terminal **in response to a receiving input selecting a link**.

The network of *Owa et al.* is a GPS system that calculates the location of a mobile terminal, but it does not receive content related to a link, as claimed, i.e., “receiving content via the mobile communication network, the content related to the link and also related to the location of the mobile terminal”-claim 19. The GPS receiver and network in *Owa et al.* performs one, and only one, task, viz., determining the location of the mobile terminal. It does not, and cannot, transmit content related to a link, as claimed. Therefore, it should be clear that *Owa et al.* does not disclose a “mobile communication network,” as claimed. Therefore, there would have been nothing in *Owa et al.* suggestive of employing two different networks, having the claimed relationship, or of combining *Owa et al.* with the systems of *Rangan et al.* and/or *Bandera et al.* in any manner that would result in a mobile communication network, as claimed.

At page 14 of the Answer, the Examiner alleges that Appellant has argued the references individually. Appellant disagrees. While the arguments in the principal brief may address certain features of each reference, this has been done in order to provide the framework of the teaching of each reference, providing evidence as to why the combination of references would have been improper. For example, there would have been no reason, within the meaning of 35 U.S.C. § 103, to combine any teaching of *Owa et al.* regarding the use of two different networks (even if such teaching existed, which it does not) with the hyperlinking of *Rangan et al.* because *Rangan et al.* discloses only a receiver that is configured to receive digital broadcasting over a digital broadcasting network wherein the video is received via the digital broadcasting network, and there is no place, in *Rangan et al.*, nor reason to include, another, different network, “wherein the mobile communication network is a different network than the digital broadcasting network.”

The Examiner has clearly taken bits and pieces of different references and, without a cogent rationale, combined them together with an eye on the instant claimed subject matter. Such use of impermissible hindsight is not a proper basis for an obviousness rejection under 35 U.S.C. § 103.

Since the Examiner's combination of references is based on impermissible hindsight and since, even in making the combination, none of the applied references discloses or suggests the claimed feature of "the mobile communication network is a different network than the digital broadcasting network," the Examiner's rationale is flawed and no *prima facie* case of obviousness has been established.

Accordingly, the Honorable Board is respectfully requested to reverse the Examiner's rejections under 35 U.S.C. § 103.

IV. CONCLUSION AND PRAYER FOR RELIEF

The claims require at least "the mobile communication network is a different network than the digital broadcasting network," but none of the applied references discloses or suggests this claimed feature. Appellant, therefore, requests the Honorable Board to reverse each of the Examiner's rejections.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

DITTHAVONG MORI & STEINER, P.C.

November 20, 2009
Date

/Phouphanomketh Ditthavong/
Phouphanomketh Ditthavong
Attorney for Applicant(s)
Reg. No. 44658

Errol A. Krass
Attorney for Applicant(s)
Reg. No. 60090

918 Prince Street
Alexandria, VA 22314
Tel. (703) 519-9952
Fax (703) 519-9958